

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 24-52 and 54 are pending in this case. Claims 24, 47, and 54 are amended by the present amendment with support in the originally filed disclosure at least at Fig. 4 and the related descriptions. Thus, no new matter is added.

In the outstanding Office Action, Claims 24-27, 29, 30, 32-36, 38, 43, 45-50, 52, and 54 were rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi (U.S. Pub. No. 2002/0141380) in view of Levin, et al. (U.S. Pub. No. 2002/0149784, herein "Levin"); Claims 28, 31, 39-42, 44, and 51 were rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi in view of Levin, further in view of Ben-Chorin, et al. (U.S. Patent No. 7,352,488, herein "Ben-Chorin"), and Claim 37 was rejected under 35 U.S.C. § 103(a) as unpatentable over Koguchi in view of Levin, further in view of Kajita, et al. (U.S. Patent No. 6,069,706, herein "Kajita").

Applicants and Applicants' representative thank Examiner Dulaney for the courtesy of a phone conversation with Applicants' representative on May 4, 2010 to clarify the claim interpretation underlying the rejections of the pending claims.

Applicants respectfully traverse the rejections of pending Claims 24-52 and 54.

Amended Claim 24 is directed to an image processing apparatus comprising:

- a memory that stores the image data in a first format following scanning correction which includes conversion from red, green, and blue (RGB) to cyan, magenta, yellow, and black (CMYK);

- a printer engine that forms an image on a recording medium based on the stored image data in the first format, without performing additional color conversion, whenever the printer engine forms the image on the recording medium;

- a format converter that converts the first format of the stored image data to a second format that is compatible with an

external device based on predetermined conditions set in the image processing apparatus;

a controller that transfers the stored image data in the first format, over the same system bus, from the memory to the printer engine and from the memory to the format converter;

a connecting unit that connects with a network, wherein the external device is connected to the network; and

a transmitter that transmits the image data in the second format to the external device via the connection unit.

The outstanding Office Action asserts Koguchi as teaching every element of Claim 24 except the memory and the printer engine, which it asserts Levin as teaching.

Specifically, at page 3, the outstanding Office Action states that Koguchi “does not perform color correction at the time of scanning,” but asserts that Koguchi is properly modified by Levin, which shows a front end image processing step 60 prior to storage 64, by simple substitution to produce a predictable result.

The statement in the outstanding Office Action, acknowledging paragraph [0076] of Koguchi, which specifically states that Koguchi does not perform any color conversion of a scanned image prior to storage in the storage unit 12, is an admission that the proposed combination of references modifies Koguchi to include a feature that Koguchi specifically teaches away from. As such, the proposed combination of Koguchi with Levin is impermissible under MPEP § 2143.01, because the proposed modification changes the principle of operation of Koguchi.

Applicants note that predictable results alone are an insufficient basis for establishing a *prima facie* case of obviousness. The Court recently reiterated the requirement for asserting a proper motivation under MPEP § 2143.01 by stating that a “patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” KSR Int. Co. v. Teleflex Inc., 82 USPQ2d 1385,

1389 (2007). The Court noted, quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006)), “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added).

Applicants maintain that a rational underpinning is not articulated for the asserted combination in this case and, specifically, the primary reference’s teaching away from the proposed modification is not overcome by any articulated motivation.

In the interest of advancing the prosecution of this application, the image processing apparatus is further defined to include a controller “that transfers the stored image data in the first format, over the same system bus, from the memory to the printer engine and from the memory to the format converter.”

Koguchi is completely silent as to the amended features of Claim 24. Further, Fig. 2 of Koguchi shows that there is no controller between the storage unit 12, which stores the scanned image, and the printer unit 16. Further, the controller 11 of Koguchi, whether it is asserted as the controller or the format converter, as defined by Claim 24, fails to teach the “controller that transfers the stored image data in the first format, over the same system bus...from the memory to the format converter,” as recited by amended Claim 24.

The above-discussed deficiencies of Koguchi with regard to amended Claim 24 also apply to amended Claims 47 and 54 which require transferring image data in the first format by the same controller over the same general bus for both the converting and forming an image on a recording medium steps.


Further, Levin, Ben-Chorin, and Kajita fail to cure the above-discussed deficiencies of Koguchi with regard to amended Claims 24, 47, and 54.

Thus, Applicants respectfully request that the rejections under 35 U.S.C. § 103(a) of Claim 24, Claims 25-46, which depend therefrom, Claim 47, Claims 48-52, which depend therefrom, and Claim 54 be withdrawn.

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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